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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,713	06/14/2005	Walter Haussecker	022862-1041	2416
23409 7590 04/20/2009 MICHAEL BEST & FRIEDRICH LLP 100 E WISCONSIN AVENUE Suite 3300 MILWAUKEE, WI 53202				
EXAMINER				
LUONG, VINH				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/540,713

Applicant(s)

HAUSSECKER ET AL.

Examiner

Vinh T. Luong

Art Unit

3656

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 2,6,11-13,15-17,19 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7-10,14,18,20 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 June 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☒ Other: Appendix

1. Applicant's election of the species of FIGS. 1-4 in the reply filed on March 10, 2009 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse. MPEP § 818.03(a).
2. Claims 2, 6, 11-13, 15-17, 19, and 21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on March 10, 2009.
3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

4. The abstract of the disclosure is objected to because the abstract uses the implied phrase "[t]he invention concerns . . ." and the legal phraseology, such as, "means." Correction is required. See MPEP § 608.01(b).
5. The drawings are objected to because of the reasons, *inter alia*, listed below:

(a) The drawings are inconsistent with the specification. For example, paragraph [0028] of the specification describes that the second housing part 14 is made of plastic. However, FIGS. 2 and 4-6 show that the second housing part 14 is made of metal in accordance with the drawing symbols for draftsperson in MPEP 608.02. Please see 37 CFR 1.121(c); and/or

(b) The drawings are not in compliance with 37 CFR 1.84. For example, 37 CFR 1.84(q) states that the lead lines must originate in the immediate proximity of the reference character and extend to the feature indicated. However, in FIG. 3, the lead line originated from the reference character 48 is not extended to the centering pin that has bevels 60 and 66.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

6. The disclosure is objected to because of the following informalities: the specification is inconsistent with the drawings. For example, paragraph [0028] of the specification describes that the second housing part 14 is made of plastic. However, FIGS. 2 and 4-6 show that the second housing part 14 is made of metal in accordance with the drawing symbols for draftsman in MPEP 608.02. Please see 37 CFR 1.121(e). Appropriate correction is required.

7. Claims 1, 3-5, 7-10, 14, 18, 20, and 22 are objected to because of the following informalities: the claims have typographical or grammatical error(s). For example, the term "Drive unit" in line 1 of claim 1 should have been changed to "A drive unit." Appropriate correction is required.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1, 3-5, 7-10, 14, 18, 20, and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "*can be connected*" in claim 1 is vague and indefinite in the sense that things which may be done are not required to be done. For example, the second housing part can be, but is not required structurally to be connected by means of connecting elements (40). See "crimpable" in *In re Collier*, 158 USPQ 266 (CCPA 1968), "discardable" in *Mathis v. Hydro Air Industries*, 1 USPQ2d 1513, 1527 (D.C. Calif. 1986), "removable" in *In re Burke Inc.*, 22 USPQ2d 1368, 1372 (D.C. Calif. 1992), and "comparable" in *Ex parte Anderson*, 21 USPQ2d 1241, 1249 (BPAI 1992).

The term "sleeve-like" in claim 4 is indefinite since the specification does not define what is "like" a sleeve but is not the sleeve. In other words, the phrase "sleeve-like" renders the claim indefinite because the claim includes elements not actually disclosed (those encompassed by "like the sleeve"), thereby rendering the scope of the claim(s) unascertainable. See "or the like" in MPEP § 2173.05(d).

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 3, 7, 9, 10, 18, and 22, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Hager et al. (WO 01/61133 A1 cited in the specification).

Claim 1

Hager teaches a drive unit (FIG. 1) for actuating drives in a motor vehicle with a first housing part (2), in particular a pole pot (2), and a second housing part (15) which can be connected by means of connecting elements (4), wherein the first housing part (2) features receptacles (5) for the connecting elements (4), characterized in that the receptacles (5) are embodied as centering holes (*i.e.*, a centering bore hole of a counter receptacle 6. See paragraph [0003] of Applicant's specification and Appendix hereinafter "App.") for corresponding centering pins, *i.e.*, the screws 4 (the screws 4 are capable of being similar to the screws 50 shown in Applicant's FIG. 2), which are arranged on the second housing part (14).

As noted, Hager's FIG. 1 is substantially identical or clearly identical to Applicant's FIG. 1. Therefore, Hager's receptacles 5 inherently have the centering (bore) holes for the connecting elements or screws 4 in the same manner as Applicant's receptacles as admitted by Applicant in the description of WO 01/61133 in paragraphs [0002] and [0003] of Applicant's specification. As noted, a prior art reference may anticipate when the claim limitation or limitations not expressly found in that reference are nonetheless inherent in it. *Prima Tek II LLC v. Polypap S.A.R.L.*, 75 USPQ2d 1219, 1223 (Fed. Cir. 2005).

Claim 3

The second housing part (15) features counter receptacles (6) for the connecting elements (4), which are surrounded at least partially by the centering pins (4).

Claims 7 and 18

Hager teaches that the centering holes (not shown) are arranged as through bore holes in a flange (see paragraph [0003] of Applicant's specification and App.) whose thickness (D in App.) is inherently greater than the height of the centering pin (4) as seen in App.

Claims 9 and 22

The first and second housing parts (2, 15) are assigned bearing functions for an armature shaft (14).

Claim 10

The counter receptacles (64) are embodied as centering bore holes as admitted in paragraph [0003] of Applicant's specification. The bore holes inherently include pocket holes or through holes.

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. Claims 4, 5, 8, 14, and 20, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hager in view of Nolte et al. (USP # 4,938,086).

Claim 4

Hager teaches the invention substantially as claimed. However, Hager does not teach the centering pins embodied to be sleeve-like.

Nolte teaches the centering pins (50) embodied to be sleeve-like in order to facilitate the assembling of parts 20, 22. Nolte, Summary of the Invention.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to embody Hager's centering pins to be sleeve-like in order to facilitate the assembling of Hager's first and second housing parts as taught or suggested by Nolte. The modification of Hager's drive unit by embodying the centering pins to be sleeve-like as taught or suggested by Nolte would not have been uniquely challenging to a person of ordinary skill in the art because it is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement." *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) and it "does no more than yield predictable results." *KSR* at 1739.

Claims 5 and 14

See lead-in bevels (80) formed on Nolte's centering pins (50).

Claims 8 and 20

Nolte's centering pin (50) forms a clearance fit together with the centering holes (60).

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Coleman (bevel 94), La Barge et al. (bevel 13), and Gersbach (FIG. 4).

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vinh T Luong/
Primary Examiner, Art Unit 3656